

REMARKS

This Application has been carefully reviewed in light of the Office Action dated January 16, 2007. In the Office Action, Claims 1-14 are pending and stand rejected. Applicants have added new Claims 15 and 16. Applicants respectfully request reconsideration and favorable action in this case.

Section 101 Rejections

The Office Action rejects Claims 1-14 under 35 U.S.C. §101 because the claimed invention lacks patentable utility and/or is directed to non-statutory functionality. Specifically, the Examiner states that Claims 1-14 are rejected as not producing a useful result. (Office Action, page 2). Additionally, the Examiner states that Claims 1-14 are rejected as being an abstract idea, directed solely to non-functional descriptive material. (Office Action, page 2). Finally, the Examiner states that Claims 1-7 are directed merely to an abstract idea which would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. §101. (Office Action, page 2). Applicants respectfully traverse these rejections.

Claims 1-14 are directed to statutory subject matter because each claim produces a useful, concrete, and tangible result. In section 101, Congress deemed that “any new and useful process” constitutes patentable subject matter:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

35 U.S.C. § 101. The Supreme Court and Federal Circuit have interpreted the statute broadly, stating that statutory subject matter should essentially “include anything under the sun that is made by man.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1355, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999) (citing *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 U.S.P.Q. 193 (1980)). The courts have, however, specifically identified three categories of subject matter that are not patentable: laws of nature, natural phenomena, and abstract ideas. *Id.* (citing *Diamond v. Diehr*, 450 U.S. 175, 185, 209 U.S.P.Q. 1 (1981)). A

mathematical formula or algorithm in the abstract is also considered to be unpatentable subject matter. *Id.* at 1356. But, “[b]ecause § 101 includes processes as a category of patentable subject matter, the judicially-defined proscription against patenting of a ‘mathematical algorithm,’ to the extent such a proscription still exists, is narrowly limited to mathematical algorithms in the abstract.” *Id.*

The Federal Circuit has clarified that a method claim qualifies as patentable subject matter when it “produces a useful, concrete, [and] tangible result.” *Id.* at 1358. There is no requirement of a physical transformation, or the like. *Id.*

Applicants submit that independent Claims 1 and 8 each produce a useful, concrete, and tangible result and, thus, are directed to statutory subject matter. Claims 1 and 8 do not identify a law of nature, natural phenomenon, or abstract idea. Claims 1 and 8 are not abstract mathematical algorithms. Claim 1 requires “arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix.” As required in Claim 1, “each User object represent[s] a Web Services Account.” Claim 1 further requires “arranging Business Entity object(s) under User object(s)” and “arranging corresponding TModel object(s) under at least one of User object(s), Repository object and Prefix.” Thus, instead of constituting nonstatutory subject matter, Claim 1 produces a useful, concrete, and tangible result. Likewise, independent Claim 8 produces a useful, concrete, and tangible result and is directed to statutory subject matter for substantially similar reasons.

Thus, Applicants respectfully submit that Claims 1 and 8 are directed to statutory subject matter. Because Claims 1 and 8 are directed to statutory subject matter, Applicants respectfully request the Board to direct the Examiner to withdraw the rejection of Claims 1-14 under 35 U.S.C. § 101.

Section 102 Rejections

The Office Action rejects Claims 1 and 8 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0213409 issued to Murto et al. (“*Murto*”). Applicants respectfully request reconsideration and allowance of Claims 1 and 8 for the reasons discussed below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*).

Independent Claim 1 of the present Application recites:

A method for use in a Web Services arrangement comprising:
arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix, each User object representing a Web Services account;
arranging Business Entity object(s) under User object(s); and
arranging corresponding TModel object(s) under at least one of User object(s), Repository object and Prefix.

Whether considered alone or in combination with any other cited references, *Murto* does not disclose, either expressly or inherently, each and every element of Claim 1.

For example, *Murto* does not disclose, teach, or suggest "arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix," as recited in amended Claim 1. Generally, *Murto* relates to a system and method "to enable a mobile phone or wireless PDA to discover Internet businesses and services by accessing the Universal Description, Discovery and Integration (UDDI) registry using a user's location or coordinates." (Abstract). More specifically, *Murto* discloses using a wireless device to submit a user query request that "involves query terms for browsing the UDDI registry for website URLs." (Page 4, paragraph 59, lines 1-2). The browsing "allows the user to explore and examine data organized by the UDDI registry in a hierarchy." (Page 4, paragraph 59, lines 3-4). The "hierarchical relationships" disclosed in *Murto* include "four types of data: business information, service information, binding information, and information about specifications for services." (Page 4, paragraph 59, lines 6-9). Thus, the

hierarchy disclosed in *Murto* does not relate to an arrange of objects that include “User object(s),” “Repository object(s) collectively forming a Prefix,” “Business Entity object(s),” and “TModel object(s).” Rather, the hierarchy is limited to business information, service information, binding information, and information about specifications for services organized in the UDDI registry.

In the Office Action, the Examiner relies upon Figure 4A and paragraphs 12, 94, and 169 as disclosing the recited claim elements. As disclosed in *Murto*, Figure 4A “is a more detailed functional block diagram of the server, showing the knowledge engine.” (Page 3, paragraph 33, lines 1-2). Although server 140 is shown and described in paragraph 169 as including “user data 146 which includes the user ID profile 230,” there is no disclosure of “arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix,” as recited in Claim 1. Knowledge engine 12 is merely a program that includes steps to “receive user’s query” and “access UDDI registry with user’s query to identify web sites using appended locator.” (Page 9, paragraphs 155 and 158). The list of websites is returned to the user and the query and binding templates are stored in the user profile. (Page 9, paragraph 159). The user profile 232 merely is described as including “the user’s name and email address, the user’s search handles, the UDDI search strategies, the sorting and filtering specifications, selected URLs, selected document titles, and binding templates which contain URLs.” (Page 7, paragraph 94). *Murto* does not disclose, teach, or suggest, however, “arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix,” as recited in amended Claim 1.

As another example, *Murto* does not disclose, teach, or suggest “arranging Business Entity object(s) under User object(s),” as recited in amended Claim 1. In the Office Action, the Examiner relies upon Figure 4A and paragraphs 59-60 and 116-121 as disclosing the recited claim elements. However, the user profile 232 illustrated in 232 is not shown to have “Business Entity object(s)” arranged “**under** User object(s). (See Figure 4A, reference numerals 230 and 232). Although paragraphs 59-60 of *Murto* discuss “businessEntity XML” elements, such discussion merely indicates that the business information is one of “four types of data” that is “organized by the UDDI registry in a hierarchy.” However, there is no disclosure in *Murto* that the UDDI registry includes User Object(s). Thus, even if the UDDI

registry includes businessEntity XML elements, *Murto* cannot be said to disclose, teach, or suggest “arranging Business Entity object(s) under User object(s),” as recited in amended Claim 1.

For at least these reasons, Applicants request reconsideration and allowance of Claim 1.

Similar to Claim 1, Claim 8 includes a limitation regarding “arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix.” Claim 8 also includes a limitation regarding “arranging Business Entity object(s) under User object(s). Therefore, for similar reasons discussed above with regard to Claim 1, Applicants respectfully contend that Claim 8 is allowable over *Murto*. For at least these reasons, Applicants request reconsideration and allowance of Claim 8.

Section 103 Rejections

The Office Action rejects Claims 2-7, and 9-14 under 35 U.S.C. §103(a) as being unpatentable over *Murto* in view of U.S. Patent Application Publication No. 2004/0002955 A1 of Gadbois et al. (“*Gadbois*”). Applicants respectfully request reconsideration and allowance of Claims 2-7 and 9-14 for the reasons discussed below.

Dependent Claims 2-7 and 9-14 depend upon independent Claims 1 and 8, respectively, which Applicants have shown above to be allowable. Accordingly, dependent Claims 2-7 and 9-14 are not obvious over the proposed *Murto-Gadbois* combination at least because Claims 2-7 and 9-14 include the limitations of their respective independent claims. Since Claims 2-7 and 9-14 incorporate the limitations of their respective independent claims, Applicants have not provided detailed arguments with respect to Claims 2-7 and 9-14. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 2-7 and 9-14.

Furthermore, Applicants respectfully submit that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants’

invention to modify or combine *Murto* with *Gadbois* in the manner suggested by the Examiner. Applicants' claims are allowable for at least this additional reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* ***Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “*The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a

blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

As the basis for the proposed *Murto-Gadbois* combination, the Examiner states that “[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified *Murto* by the teaching of *Gadbois* because arranging publisher assertion object(s) under business entity object(s) would enable an efficient means of recording and publishing assertions regarding business organization relationships (peer-to-peer, parent-subsidary, etc.) by different business organizations or their authorized publishing entities and an efficient means of managing publisher assertions (*Gadbois*, paragraph 4). However, as stated above, *Murto* merely relates to a system and method “to enable a mobile phone or wireless PDA to discover Internet businesses and services by accessing the Universal Description, Discovery and Integration (UDDI) registry using a user’s location or coordinates.” (Abstract). More specifically, *Murto* discloses using a wireless device to submit a user query request that “involves query terms for browsing the UDDI registry for website URLs.” (Page 4, paragraph 59, lines 1-2). *Murto* does not relate at all to publisher assertion object(s) and neither reference provides an motivation of suggestion as to why one of ordinary skill in the art at the time of Applicants’ invention would have been motivated to combine the method for browsing a UDDI registry as disclosed in *Murto* with the set of nodes representative of organizations as disclosed in *Gadbois*.

It appears that the Examiner has merely proposed alleged advantages of combining *Murto* with *Gadbois* (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portion of *Gadbois* that touts an advantage of its system, the Examiner has not pointed to any portions of the cited references that would actually teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the set of nodes representative of organizations as disclosed in *Gadbois* into method for browsing a UDDI registry as disclosed in *Murto*. In other words, the alleged advantage of the system disclosed in *Gadbois*

does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the particular techniques disclosed in *Murto* with the cited disclosure of *Gadbois*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicants' claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2-7 and 9-14.

New Claims 15 and 16 are Allowable

New Claims 15 and 16 have been added and depend on Claims 1 and 8, respectively, which Applicants have shown above to be allowable. Claims 15 and 16 are patentable at least because of this dependency and further because they recite additional features not disclosed, taught, or suggested in the prior art. Accordingly, Applicants respectfully request consideration and allowance of new Claims 15 and 16.

CONCLUSION

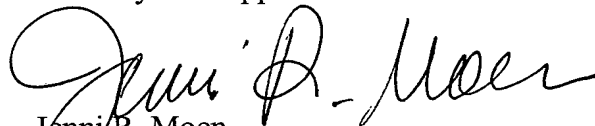
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Jenni R. Moen", is written over the printed name and registration information.

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